

Remarks:

Claims 16-32 are pending.

Claims 1-15 are cancelled, without prejudice or disclaimer.

Claims 16-32 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 6,558,792 (Vaabengaard) further in view of U.S. Pub. No. 2005/0080155 (Fattman). Reconsideration is requested.

First of all, the PTO based the §103(a) rejection of claims 16-32, and the §103(a) rejection of claims 33 and 34 (discussed below) on a new rationale, albeit relying on the same prior art. Therefore withdrawal of the "final" status of the rejections (i.e., reopening prosecution) is in order (see below). Secondly, notwithstanding applicants' entitlement to withdrawal of the "final" status of the rejections and the reopening of prosecution, the rejections under §103(a) cannot be maintained for the following reasons.

In the context of a rejection for obviousness under §103, the "Examiner bears [both] the initial burden . . . of presenting a *prima facie* case of unpatentability" and "the ultimate burden of persuasion on the issue." *In re Oetiker*, 24 USPQ 1443, 1444 and 1447 (Fed. Cir. 1992).

The Examiner can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art *would lead* that individual to combine the relevant references. . . . Indeed, the teachings of the references can be combined only if there is some suggestion or incentive to do so.

Ex parte Obukowicz, 27 USPQ2d 1063, 1065 (BPA&I 1992) (*emphasis added*).

The fact that all elements of a claimed invention are known does not, by itself, make the combination obvious. *Ex parte Clapp*, 227 USPQ 972 (BPA&I 1985). To support a rejection for obviousness based on the combination of separate prior art teachings "even when the level of skill is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination." *In re Rouffet*, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998).

The mere fact that it is possible to find two isolated disclosures which might be combined in such a way as to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the *desirability* of the proposed combination.

In re Bergel, 130 USPQ 206, 208 (CCPA 1961) (*emphasis added*).

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986). The totality of each reference's teachings must be considered when combining those teachings with the rest of the prior art. *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

"There is no suggestion to combine ... if a reference teaches away from its combination with another source." *Tec Air, Inc., v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999). If the first of two cited references "teach[es] away from [the second reference], then that

finding alone can defeat [the alleged] obviousness claim." *Winner Int'l. Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000), *cert. denied*, 530 U.S. 1238 (2000).

The properties exhibited by a claimed invention must be taken into consideration when comparing the claims against the prior art, whether or not the properties are recited in the claims. *In re Estes*, 164 USPQ 519 (CCPA). See, *In re Papesch*, 137 USPQ 43, 51 (CCPA 1963). *Prima facie* obviousness "will be rebutted if . . . there are new and unexpected results relative to the prior art" [citation omitted]. *Iron Grip Barbell Co. v. USA Sports Inc.*, 73 USPQ2d 1225, 1228 (Fed. Cir. 2004).

The presently claimed "adhesive composition" comprises (a) a block-copolymer and (b) a homopolymer; an embodiment being a polyisobutylene-styrene block copolymer (PIBS) and a polyisobutylene homopolymer (PIB). Vaabengaard teaches an adhesive composition, which comprises a block-copolymer and a homopolymer, in which the homopolymer is PIB, as in the present claims, but which block-copolymer is not PIBS but, rather, poly(styrene-isoprene-styrene) (SIS). As admitted in the statement of rejection (final action, page 4), "Vaabengaard teaches . . . a styrene-isoprene-styrene [SIS] copolymer wherein isoprene is a linear *unsaturated* hydrocarbon . . . [but] is silent with respect to the styrene copolymer containing a linear *saturated* hydrocarbon having the same chemical structure as the rubbery polyisobutylene [PIB] component" [*emphasis original*]. Allegedly, it would have been obvious to use the "linear *saturated* hydrocarbon" SIBS instead of the "linear *unsaturated* hydrocarbon" SIS in Vaabengaard "since Fattman teaches SIBS is also [i.e., as well as SIS] resistant to stomal effluent [in paragraph] [0038] (final action, page 4).

With all due respect, the rejection is poorly taken, because the requirements for establishing the requisite *motivation to combine* the cited references have not been satisfied, allegations to the contrary in the rejection notwithstanding, and because teachings in the cited references, themselves, actually contraindicate, i.e., teach away from, combining the cited references as alleged in the rejection.

By way of review, Fattman describes an adhesive composition comprising a multiblock polymer. The multiblock polymer can be SIS or SIBS. Fattman does not disclose an adhesive composition comprising PIB. Thus, the adhesive composition according to Fattman is based solely on the polymer of SIS or SIBS. The choice of either SIS or SIBS for use in the adhesive composition is, therefore, without any consideration as to the inclusion of PIB in the adhesive composition. Thus, there is no teaching or suggestion in Fattman to make an adhesive composition comprising SIBS (or SIS) with the addition of PIB.

Vaabengaard (Abstract and column 3, lines 12-21) teaches "a pressure sensitive adhesive composition . . . comprising a rubbery elastometric base and two or more water soluble or water swellable hydrocollods" and, optionally, a "cohesive strengthening agent, . . . plasticizer and . . . pigment." While Vaabengaard Example 5 does disclose an adhesive composition comprising PIB as the rubbery component and SIS as the optional cohesive strengthening agent, as stated in the rejection, other teachings of the cited reference, not mentioned in the rejection, must be taken into consideration. *Hedges*, 228 USPQ at 687. *W.L. Gore & Assoc., Inc.*, 220 USPQ at 311.

The adhesive composition comprising components SIS and PIB is only one among many combinations of two components—generically defined as a rubbery component and a cohesive strengthening agent—selected from two lists of alternatives. As taught by Vaabengaard (column 4, lines 28-31):

The rubbery component or components used in the adhesive of the invention may be a conjugated butadiene polymer such as polybutadiene, polyisobutylene or polyisoprene, preferably polyisobutylene.

A cohesive strengthening agent may suitably be a physically cross-linked elastomer selected from block-copolymers of styrene, a chemically cross-linked natural or synthetic rubbery elastomer and/or a rubbery homopolymer, optionally together with a plasticizer or a tackifier resin.

A physically cross-linked elastomer selected from block-copolymers comprising styrene and one or more butadienes may be a styrene-butadiene-styrene copolymer, a styrene-isoprene copolymer and is preferably a mixture of styrene-isoprene-styrene and styrene-isoprene copolymer.

A chemically cross-linked rubbery elastomer may e.g. be butyl rubber or natural rubber.

A rubbery homopolymer may be a polymer of a lower alkene such as low density polyethylene or propylene, preferably atactic polypropylene (APP). . . .

A cohesive strengthening agent may suitably be a physically crosslinked elastomer comprising a styrene-butadiene-styrene copolymer or a styrene-isoprene-styrene copolymer. Such copolymers may preferably comprise 0-10% of a plasticizer, preferably dioctyl adipate.

The rubbery component is described in Vaabengaard as a conjugated butadiene polymer, with PIB being but one example. One example of cohesive strengthening agent is a physically cross-linked elastomer, and SIS is but one example of the example. SIBS is not mentioned anywhere.

Thus, an adhesive composition combining PIB with SIS is but one, possible embodiment from among a very large number of alternative combinations suggested (albeit a combination described in the Vaabengaard working examples). From this sole alternative, it would have allegedly

been obvious to change the cohesive strengthening agent to a non-disclosed material, i.e., SIBS, despite there being no teaching or suggestion in the reference to use (1) SIBS in an adhesive composition, (2) SIBS in an adhesive composition with PIB, or (3) SIBS in an adhesive composition with PIB together with a reason (i.e., motivation) to do so, such as an explanation of the discovered advantages described in applicants' instant application regarding the compatibility between SIBS and PIB.

The rejection focuses on the teaching of Fattman paragraph [0038], which references the testing that showed good resistance to stomal effluent of a "multi-block copolymer of styrene and olefin," exemplified in the test examples by, *i.a.*, SIS and SIBS. Since Vaabengaard described adhesives that are resistant to biological fluids, the PTO concludes, wrongly, that it would have been obvious to modify Vaabengaard to produce an adhesive composition comprising SIBS combined with PIB instead of SIS, since Fattman teaches that both are resistant to Stomal effluent. The conclusion constitutes impermissible hindsight, since neither Fattman nor Vaabengaard teaches or suggests making an adhesive composition comprising both SIBS and PIB, and the PTO has failed to sustain its initial burden. *Oetiker*, 24 USPQ at 1444.

The motivation to combine allegedly provided by Fattman improperly focuses on selected teachings of the cited references to support the rejection "to the exclusion of other parts necessary to the full appreciation of what [each] such reference fairly suggests to one of ordinary skill in the art." *Hedges*, 228 USPQ at 687. Vaabengaard teaches the purpose/function of using SIS is to give the adhesive composition cohesive strength; whereas, Fattman teaches that the purpose/function of

SIS, or alternatively PIBS, is to make the "adhesive . . . resistant to stomal effluent" [Abstract]. Accordingly, since Fattman teaches that SIS provides good resistance to stomal effluent, and Vaabengaard (already) uses SIS, the person skilled in the art reading Vaabengaard in view of Fattman would have found Vaabengaard (already) exhibited the resistance to stomal effluent taught by Fattman by virtue of (already) using SIS; and, therefore, Fattman effectively "teaches away from its combination with [Vaabengaard]," *Tec Air, Inc.*, 52 USPQ2d at 1298, which defeats the obviousness rejection. *Winner Int'l. Royalty Corp.*, 53 USPQ2d at 1587.

Moreover, nothing in the cited references teaches or suggests that SIBS exhibits the same "cohesive strength" properties exhibited by SIS. And, therefore, the rejection falls for failing to establish the requisite "foreseeability or predictability" that the replacement material will function the same as (i.e., satisfy the purpose of) the material replaced. Obviousness to combine requires "a reasonable expectation of success." *In re Vaeck*, 20 USPQ2d 1438, 1441 (Fed. Cir. 1991). *Procter & Gamble Co. v. Teva Pharmaceuticals USA, Inc.*, 90 USPQ2d 1947, 1951 (Fed. Cir. 2009). See *KSR International Co. v. Teleflex, Inc.*, 550 U.S. 398, 127 SCt 1727, 82 USPQ2d 1385 (2007).

It should also be pointed out that the combined teachings of the cited references provide no motivation to use SIBS as an additional component in Vaabengaard, and the combined teachings of the cited references actually teach away from doing so, for the same reasons (set forth above) that it would not have been obvious to use SIBS instead of SIS. That is, in view of Fattman, the skilled artisan would consider Fattman's taught advantage of resistance to stomal effluent is (already) found in Vaabengaard, by virtue of Vaabengaard using SIS, since Fattman teaches that SIS provides the

adventageous resistance to stomal effluent. Reaching any other conclusion would involve speculation by the PTO, which "is not prior art." *In re Rijkaret*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The PTO cannot "resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis." *In re Warner*, 154 USPQ 173, 178 (CCPA 1967). Accordingly, it would not have been obvious to combine SIBS with PIB based on modifying Vaabengaard in view of Fattman, whether by replacing SIS with SIBS or by simply adding SIBS as another component.

Moreover, the PTO totally ignores, incorrectly, the unexpected advantages of preparing an adhesive composition comprising both PIB and SIBS as described and claimed in the subject application, supporting data of which are shown in the instant application, itself. *In re Margolis*, 228 USPQ 940 (Fed. Cir. 1986) (a showing in the specification of unexpected results must be taken into account by the examiner in a §103(a) analysis). For example, page 4, lines 8-18, teaches that homopolymers of PIB are not fully compatible with the isoprene phase of the SIS block copolymer (effecting certain consequences, listed thereafter). Furthermore, the unsaturated chemical bonds of SIS cause yellowing and deterioration. SIBS does not have these disadvantages. As another example, page 6, lines 1-15, of the subject application teaches that SIBS offers superior softness and barrier properties, due to the soft block of the polymer (the "IB" isobutylene block). The isoprene block of SIS does not have the same characteristics. Thus, there is a good comparability between the soft segment of the block copolymer and the homopolymer (page 6, lines 11-12). As still another example, page 8, line 13 - page 9, line 2, of the specification teaches the advantages of using SIBS

instead of SIS. The data reported in, and the resulting conclusions stated after, application Tables 3 and 4 verify the aforesaid, unexpected advantages, and any alleged *prima facie* obviousness of combining PIB with SIBS based on the cited references is effectively rebutted, *Iron Grip Barbell Co.*, 73 USPQ2d at 1228, keeping in mind the advantages need not be recited in the claims. *Estes, supra.*

In view of the foregoing remarks, the rejection of claims 16-32 under §103(a), based on the teachings of Vaabengaard in view of Fattman, is overcome. Withdrawal of the rejection is in order.

Claims 33 and 34 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Vaabengaard in view of Fattman further in view of U.S. Patent No. 5,109,874 (Bellingham). Reconsideration is requested.

The reliance on Vaabengaard in view of Fattman is misplaced, for the same reasons set forth above, with respect to the rejection of claims 16-32. Bellingham fails to teach or suggest anything that would cure the fatal deficiencies—explained above—in the reliance on Vaabengaard in view of Fattman. Since present claims 33 and 34 are dependent, directly or indirectly, on present claim 16 (shown to be patentable, above), the rejection of claims 33 and 34 under §103(a) cannot be maintained. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988).

In view of the foregoing remarks, the rejection of claims 33 and 34 under §103(a), based on the teachings of Vaabengaard in view of Fattman, and further in view of Bellingham, is overcome. Withdrawal of the rejection is in order.

***Request Under MPEP 706.07(d) to Withdraw
Premature Final Office Action***

Request is made, hereby, for reconsideration and withdrawal of the "Final" Office Action, mailed July 7, 2010 (the "final action"), and for a new, non-final action in place of the final action, which new action restarts the time period for response. As explained, below, withdrawing finality of the final action is required, in accordance with MPEP 706.07(a) and 706.07(d), because the final action contains new grounds of rejection, not necessitated by any applicant amendment, which renders the finality premature.

Where finality of an Office Action is "premature," the "finality of the Office Action must be withdrawn." MPEP 706.07(d). Finality is "premature," for purposes of MPEP 706.07(d), where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

MPEP 706.07(a) (emphasis added). "The criterion of whether a rejection is considered new" is whether the applicant "had a fair opportunity to react to the thrust of the rejection." *In re Kronig*, 190 USPQ 425, 426 (CCPA 1976). *Ex parte Maas*, 14 USPQ2d 1762, 1764 (BPA&I 1990).

Both §103(a) rejections rely on a new rationale (i.e., ground) of rejection, albeit relying on the same prior art. Both §103(a) rejections had previously relied on the "superior migration resistance" properties of SIBS (styrene-isobutylene-styrene copolymer) allegedly taught in Fattman paragraph [0058] (Office Action mailed February 5, 2010). The instant rejections do not rely on paragraph [0058] or any "superior" migration resistance of SIBS.

That the PTO no longer relies on "the benefit of superior migration resistance" of SIBS, and Fattman paragraph [0058], may well be due to applicants' showing that Fattman paragraph [0058] was misinterpreted in the rejection, since it did not, in fact, teach any "superior migration resistance" properties of SIBS (Amendment filed April 12, 2010, paragraph bridging pages 4 and 5). In any event, the PTO does not challenge applicants' showing—that Fattman paragraph [0058] did not, in fact, teach any "superior migration resistance" properties of SIBS—which, of course, now stands as having been admitted by the PTO. *In re Soni*, 34 USPQ2d 1684, 1688 (Fed. Cir. 1995) (PTO failure to rebut applicant's argument constitutes PTO admission that argument is correct).

Instead of maintaining the rejections based on an interpretation of Fattman paragraph [0058] (i.e., "superior migration resistance" properties of SIBS), both rejections rely (mistakenly, as explained above) on the "good resistance to stomal effluent" of both SIBS and SIS—allegedly supporting use of both SIBS and PIB in an adhesive composition, as explained above—taught in paragraph "[0038]" of the reference (final action, page 4).

The problem with shifting the rejection's rationale—from the "superior migration resistance" of SIBS, and Fattman paragraph [0058]—is that applicants have had no fair opportunity to rebut the rejection's reliance on Fattman paragraph [0038] (i.e., until now, and applicants have done so, above). The PTO's admitted reliance on misinterpreted teachings of Fattman did not provide applicants a fair opportunity to rebut the PTO reliance on teachings specified elsewhere in the reference. Having had no "fair opportunity" to rebut the new reliance/rationale renders both final

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rejections "new" grounds of rejection. *Kronig*, 190 USPQ at 426. *Maas*, 14 USPQ2d at 1764. MPEP 706.07(a). MPEP 706.07(d).

It goes without saying, of course, that the new grounds of rejection were not necessitated by any applicant amendment. That is, the claims were not amended in response to the previous Office Action.

Accordingly, since the "new" rationale/grounds of rejection were in no way "necessitated by applicant's amendment," finality of the final action was "premature." MPEP 706.07(a). Being "premature," the "finality of the Office Action must be withdrawn." MPEP 706.07(d). A new, non-final Office Action issued by the PTO is in order, in place of the final action, which new action resets the time period for response as of its mailing date.

Favorable action is requested.

Respectfully submitted,

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